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09/883,014	06/15/2001	Michael Smith	1826 (42059-01360)	9634

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/883,014

Applicant(s)

SMITH, MICHAEL

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-11, 14-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11, 14-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites "The method of claim 13." There is insufficient antecedent basis for claim 14 because claim 13 has been cancelled.

Claim 18 recites "The system of claim 17." There is insufficient antecedent basis for claim 18 because claim 17 has been cancelled.

Claim 19 recites "The system of claim 18." There is insufficient antecedent basis for claim 19 because there is insufficient antecedent basis for claim 18.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-11, 15, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub No US 2002/0131573 issued to Berkley et al (hereafter Berkley) in view of US Pat No 5,293,470 issued to Birch et al (hereafter Birch).

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Claim 8:

Berkley discloses a method for presenting address information to accessing parties in a shared directory environment comprising the steps of:

- detecting query from at least one entity over a data network seeking a first view of at least one entry in a shared directory [Fig 1, 185 and paragraph 41]
- retrieving identification information for the at least one entity, wherein the identification information includes hierarchical information associated with the at least one entity [paragraphs 45-49],

Berkley discloses the elements as noted above.

Berkley fails to disclose denying access to the first view based on the hierarchical information identifying all of the at least one entries in the directory which include the hierarchical information and presenting all of the identified at least one entries in a second view.

Birch discloses denying access to the first view [restricted access to the master per col 11, lines 52-66] based on the hierarchical information identifying all of the at least one entries in the directory which include the hierarchical information and presenting all of the identified at least one entries in a second view [shared virtual screens are replicated in each of the participating workstations per col 11, lines 52-66].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berkley to include denying access to the first view based on the hierarchical information identifying all of the at least one entries in the directory which include the hierarchical information and presenting all of the identified at least one entries in a second view as taught by Birch.

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The ordinarily skilled artisan would have been motivated to modify Berkley per the above for the purpose of ensuring data integrity [Birch, col 11, lines 52-57]

Claim 9:

The combination of Berkley and Birch discloses the elements of claim 8 as noted above.

Furthermore, Berkley discloses wherein the shared directory is configurable for supporting emessaging [paragraph 37].

Claim 10:

The combination of Berkley and Birch discloses the elements of claim 8 as noted above

Furthermore, Berkley discloses wherein the entities comprise at least one of at least one person and at least one group [paragraphs 45-49].

Claim 11:

The combination of Berkley and Birch discloses the elements of claim 8 as noted above.

Furthermore, Berkley discloses wherein identification information is configured in hierarchal form and includes at least one of company name and company location [paragraph 45].

Claim 15:

Berkley discloses:

- a server [Fig 1, 185 and paragraph 41] configured for receiving and processing queries for accessing information over at least one data network and performing functions with regards to accessing associated directories;
- a shared directory [Fig 1, 174 and paragraph 44 and paragraph 53] in communication with the server which includes a plurality of entries, each of the entries including

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hierarchical information [paragraph 49] in an additional field, the hierarchical information being associated with at least one entity having access to the shared directory,

Berkley discloses the elements of claim 15 as noted above.

Berkley fails to disclose the network server further configured to generate include a first and at least one additional view of the at least one entry, wherein access to the first view is restricted and the at least one additional view is a copy of the first view but with modified selection criteria, wherein the at least one additional view provides access to those of the plurality of entries which include the hierarchical information

Birch discloses the network server further configured to generate include a first and at least one additional view of the at least one entry, wherein access to the first view is restricted and the at least one additional view is a copy of the first view but with modified selection criteria, wherein the at least one additional view provides access to those of the plurality of entries which include the hierarchical information [col 11, lines 52-66].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berkley to include the network server further configured to generate include a first and at least one additional view of the at least one entry, wherein access to the first view is restricted and the at least one additional view is a copy of the first view but with modified selection criteria, wherein the at least one additional view provides access to those of the plurality of entries which include the hierarchical information as taught by Birch.

The ordinarily skilled artisan would have been motivated to modify Berkley per the above for the purpose of ensuring data integrity [Birch, col 11, line 54].

Claim 16:

The combination of Berkley and Birch discloses the elements of claim 15 as noted above.

Furthermore, Birch discloses wherein the data network is the internet and the interface is configured to communicate with web browsers [ Fig 5 and col 11, lines 1-19].

Claim 20:

The combination of Berkley and Birch discloses the elements of claim 15 as noted above.

Berkley discloses wherein the fields are provided for at least one of people entries and group entries in the directory [paragraph 45].

***Response to Arguments***

Applicant's arguments filed December 8, 2003 have been fully considered but they are not persuasive.

**First Applicant Argument:**

Applicant states on page 6 "Claims 8 and 15 are non-obvious in light of the cited art because neither of these references teach or suggest the use of the user identification as a means to locate and compile records from a database. In Iijima, an unlocking bit is the means which is used to access a particular portion of a data file. This unlocking bit has nothing to do with the identity of a user."

**First Examiner Response:**

Examiner is not persuaded. Iijima discloses in column 1, lines 23-35, the following:

The IC card of this type is known in U.S. Pat. No. 4,985,615 having a memory whose memory area is divided in correspondence with a plurality of files. In each file, data or the like required for performing a corresponding application is stored. **When an application identification name** is input from a terminal device in which the IC card is

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inserted, the IC card can be set in a state in which only a corresponding file can be selectively used. In this manner, when a plurality of application data are divided and stored into files provided in one IC card, the IC card can be multi-purposely utilized.

In some application, **a specific IC card must be inhibited from being used by the user of this IC card.** For example, in a credit application, when a card user is written on a black list, the use of this card by the user must be inhibited in the credit application.

Examiner concludes that Iijima does teach the use of the user identification as a means to locate and compile records from a database. However, above arguments by Applicant are now moot based on supra new grounds of rejection based on the amended claims.

**Second Applicant Argument:**

Applicant states on page 6, "In Marpe et al., the user put its own identifier in a data field such that when a search is performed, items which include that identifier are identified and retrieved."

**Second Examiner Response:**

Supra comment is now moot based on new art rejection required due to Applicant's amending of the claims.

**Third Applicant Argument:**

Applicant states on page 7, "As noted by the Examiner, Mercuriali et al does disclose directory services which are employable for providing e-messaging. However, in Mercuriali et al there is no teaching or suggestion as to with the other references cited above, the use of hierarchical information associated with a particular system user, wherein the hierarchical identifier employable to locate and built a directory specifically for that class of users which is then displayed."

**Third Examiner Response:**



Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., use of hierarchical information associated with a particular system user, wherein the hierarchical identifier employable to locate and built a directory specifically for that class of users which is then displayed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, above arguments by Applicant are now moot based on supra new grounds of rejection based on the amended claims.

**Fourth Applicant Argument:**

Applicant states on page 8, "However, in Berkley et al this information, once extracted from the user, is not used for the purpose of searching a database for records which also include this identifier, and then compiling, a view such that they are displayed to a system user."

**Fourth Examiner Response:**

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., this information, once extracted from the user, is not used for the purpose of searching a database for records which also include this identifier, and then compiling, a view such that they are displayed to a system user) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

**Fifth Applicant Argument:**

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Applicant states on page 9, "While Norwitz et al does teach that a common database may include multiple entries for different individuals or organizations, it does not teach a means (either alone or in combination with the other references) for locating entries with a common hierarchical identifier and then compiling and presenting this information to a system user. As such, in light of the arguments made above the Examiner's rejections under 35 USC Section 103(a) are respectfully traversed."

**Fifth Examiner Response:**

Examiner is not persuaded. However, in view of Applicant's amending of the claims, examiner provides supra new art rejection which does not include Norwitz et al. Above comments are thus moot.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620.

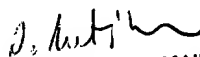
The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

February 4, 2004

  
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